

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

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BOARD OF PATENT APPEALS
AND INTERFERENCES

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte DANA C. BOOKBINDER, STEVEN A. DUNWOODY,
RICHARD M. FIACCO and ERIC M. JOHNSON

Appeal No. 2006-1827
Application No. 09/941,383¹

ON BRIEF

20 Before McQUADE, MARTIN, and GRON, Administrative Patent Judges.

GRON, Administrative Patent Judge.

REMAND

This case is an appeal under 35 U.S.C. § 134 from an examiner's final rejections of Claims 1-12, 38-43, 47 and 48.

30 A significant reference relied upon by the examiner in support of the rejections is Japanese Patent Publication No. 2000-44269, published Feb. 15, 2000 (hereafter Japan), which is prior art under 35 U.S.C. § 102(b). The reference has not been translated into English. We remand.

GROUND'S OF REJECTION

Claims 1-12, 38-43, 47 and 48 stand rejected under 35 U.S.C. § 103 as being unpatentable in view of Japan and

one or more of six other references. Answer at 4, last ¶. The examiner cites and relies on Koaizawa et al. (hereafter Koaizawa), U.S. Patent 6,543,257, which issued Apr. 8, 2003, from U.S. Application 09/545,673, filed April 7, 2000 (prior art under 35 U.S.C. § 102(e)), as an English language equivalent to Japan. Answer at 5.

DISCUSSION

Claims 1-12, 38-43, 47 and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Japan and one or more of six other references. Japan, a Japanese patent publication published Feb. 15, 2000, is not written in English. The Manual of Patent Examining Procedure (MPEP) states that when an examiner seeks to rely upon a foreign language document as prior art, "a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection." MPEP § 706.02(II) (8th ed. Rev.4, Oct. 2005). No translation of Japan has been provided to the Board of Patent Appeals and Interferences (Board).

Instead of relying on an English translation of Japan, the examiner relies on Koaizawa as "an English Language [sic] equivalent to [Japan]." Answer at 5, first ¶. However, Koaizawa is not equivalent to Japan on its face. Some apparent differences are:

¹ Filing date: August 28, 2001

- Koaizawa claims benefit of the earlier filing dates of two foreign applications under 35 U.S.C. 119. The two applications for which benefit is claimed are Japanese Application No. 11-149476 (the application published as Japan 2000-44269 (Japan)) and Japanese application No. 11-334246. See Koaizawa, Foreign Application Priority Data.
- Koaizawa includes 27 figures while Japan includes only 11 figures. Koaizawa, Figs. 1-27; Japan Figs. 1-11. Therefore, the breadth of disclosure of Koaizawa is different on its face.

In addition, the examiner attributes much of the written disclosure in Koaizawa to Japan. In the present case, the written description of Japan appears to be unknown, and therefore the reference as a whole could not have been evaluated for what it fairly teaches. It is axiomatic that "[a]ll of the disclosures in a reference must be evaluated for what they fairly teach one of ordinary skill in the art." In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Koaizawa may or may not be an accurate translation of Japan or an equivalent disclosure. For example, the examiner relies upon Koaizawa for claim 1 subject matter, which may or may not be equivalently disclosed in Japan:

- The examiner relies upon Fig. 1 of Koaizawa as disclosing elements of claim 1, finding it equivalent to Japan and therefore disclosed therein. Answer at 5-6. The comparable figure of Japan, Fig. 11, is not identical, lacking the pressure gauge that is present in Fig. 1 of Koaizawa. We cannot determine whether Koaizawa's discussion of its figures corresponds to Japan's discussion of its figures, even if the corresponding figures are substantially the same.
- The examiner relies on Koaizawa's teaching of an O-ring in its text in determining whether it would have been obvious to a person of ordinary skill in the art to replace the O-ring with the washer arrangement of appellant's claim 1. Answer at 6-7; Koaizawa, col. 4 l. 50-62. Absent a translation of Japan, we cannot know if Japan discloses the same O-ring that is taught in Koaizawa.

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For other claims, the examiner further relies upon the text of Koaizawa as equivalent to Japan for additional claim elements. Answer at 8. If the examiner wishes to rely upon Japan as the primary reference over which the claims are rejected, a human translation of Japan must be submitted so that its disclosure is directly relied upon. A computer-

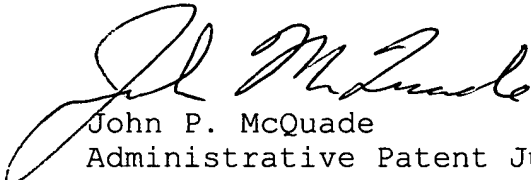
assisted translation generally has too many ambiguities. It is regularly unsatisfactory.


The examiner's reliance on Japan greatly affects the prosecution of this case. Japan qualifies as prior art under 35 U.S.C. § 102(b), because it was published in Japan more than one year before appellant's filing date of Aug. 28, 2001. Since the examiner relies upon Japan, which may bar patentability to appellant's claims under § 102(b), the applicants in this case were unable to consider the
10 possibility of antedating the reference in accordance with Rule 131. 37 C.F.R. § 1.131(a)(2)(2004). On the other hand, Koaizawa is prior art under 35 U.S.C. § 102(e), because it is a U.S. patent that was filed before appellant's filing date (Apr. 7, 2000) but issued subsequently (Apr. 8, 2003). If the examiner wishes to rely upon Koaizawa anew as the primary reference for rejections, he must enter new grounds of rejection for the claimed subject matter. Applicant would then be able to consider action under Rule 131. 37 C.F.R. § 1.131(a)(2004).


ORDER

For the reasons stated, it is ORDERED THAT this
application is remanded for action consistent with the views
expressed herein.

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John P. McQuade
Administrative Patent Judge


John C. Martin
Administrative Patent Judge


Teddy S. Gron
Administrative Patent Judge

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